

REMARKS

Two paragraphs of the specification have been amended in order to correct typographical errors. Claims 23-25 have been cancelled and new claim 26 has been added. No new matter has been added by this Amendment and further consideration of the application is respectfully requested.

In response to the Restriction Requirement mailed September 17, 2002, Applicant hereby elects the Invention of Group I(D), i.e., claims 1, 16 and 17 with traverse as noted below. Further, Applicant notes that new claim 26 depends from claim 17 and thus, new claim 26 is believed to fall within Group I(D). Therefore, claim 26 also should be examined.

With respect to the restriction of Groups I, II and III, Applicant does not traverse the restriction of Group III and the claims of Group III (i.e., claims 23-25) have been cancelled without prejudice to filing in a divisional application. However, Applicant traverses all remaining restriction requirements for the following reasons.

With respect to the restriction between Groups I and II, claim 18 has been amended so as to include all the limitations of claim 1; thus, claim 1 is generic to claim 18. In view of amended claim 18, Applicant traverses the restriction between Groups I and II, as well as the various subgroups (A-D and X-Z) that have been defined by the Examiner for the following reasons:

According to MPEP 806.03, "where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition." (Emphasis in original)

Claims 1-22 (as well as new claim 26) read upon the embodiment shown in Fig. 1-3. Thus, even if the Examiner believes that the various groups of inventions are related as

combinations and subcombinations, in accordance with MPEP 806.03, restriction should not be required, because claims 1-22 and 26 "are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition."

If the Examiner believes that MPEP 806.03 does not apply to this application, the Examiner is respectfully requested to identify specific reasons for not following the requirements of MPEP 806.03.

As an independent ground for traversing this Restriction Requirement, Applicant believes that the Examiner's interpretation and application of MPEP 806.05(c) has overlooked several significant requirements for establishing that combination and subcombination inventions are patentably distinct. In order to concisely identify the most relevant requirements, the beginning portion of MPEP 806.05(c) is reproduced herein and emphasis has been added:

"In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP Section 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations. When these factors cannot be shown, such inventions are not distinct."

Thus, two-way distinctiveness is required in order to enter a restriction requirement. That is, the subcombination must be patentably distinct from the combination and the combination must be patentably distinct from the subcombination. As an illustrative example, if a subcombination is represented by claim AB and a related combination is

represented as claim ABC, the Examiner must demonstrate that claim AB is patentably distinct from claim ABC and that claim ABC is patentably distinct from claim AB. Naturally, in some cases, claim ABC may be patentably distinct from claim AB, because claim ABC includes the additional element C, which may make claim ABC patentably distinct from claim AB. On the other hand, claim AB is not likely to be considered to be patentably distinct without persuasive evidence, because claim ABC recites all elements of claim AB. Thus, in order to establish that claim AB is patentably distinct from claim ABC, the Examiner, of course, has an elevated burden to prove patentable distinctiveness and Applicants submit that the Examiner has not provided sufficient evidence to establish that the subcombination of claim 1 patentably distinct from the various combinations, which are in fact dependent from claim 1.

It is noted that, under MPEP 804(II)(B)(1)(a), only a one-way determination of obviousness is required for an obviousness type double patenting rejection when two sets of claims are entitled to the same filing date. The standards for determining patentable distinctiveness for purposes of an obviousness double patenting rejection do not differ from the standards for determining patentable distinctiveness for the purpose of entering a restriction requirement.

Consequently, the Examiner has the burden of establishing how the particulars of the subcombination as claimed are not required for patentability of the combination. MPEP 816 ("the examiner should point out the reasons . . . why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part." (Emphasis added)). Accordingly, because the Examiner has failed to provide any evidence that establishes the respective combinations are patentable without the features of the subcombinations, the restriction requirement must be withdrawn. MPEP 806.05(c)(II) ("If there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}, restriction should not be required.")

Applicant submits that the Examiner's alleged evidence of the patentability of the

various combinations is merely statements of the dependencies of the claims. Claims submitted for examination are not assumed to be valid, because if the claims as originally filed were assumed to be valid, no examination would be necessary. Consequently, the Examiner can not rely merely upon the Applicant's organization of the claims as the sole evidence of patentable distinctness of the claims, because the particular organization of the independent and dependent claims prepared by the Applicant will not be given any presumption of validity by the Examiner during examination. Instead, the Examiner must provide some additional evidence (i.e., other than the mere organization of the claims) to demonstrate patentable distinctiveness under MPEP 806.05(c) and the Examiner has failed to do so. Therefore, because the Examiner's allegations of patentable distinctiveness are not based upon material evidence, the Examiner has failed to make a prima facie case of distinctiveness between the subcombination and the various combinations.

As another independent basis for traversing the rejection, the Examiner appears to have also failed to satisfy the requirement of showing different utilities between the respective combinations and subcombinations. It is not sufficient to merely state that a subcombination has utility without the particulars of a combination, because such an analysis is only a one-way analysis. As noted above, two-way distinctiveness is necessary under MPEP 806.05(c), which means that the utility of the subcombination must be different from the utility of the combination and naturally, the utility of the combination must be different from the utility of the subcombination. This understanding of restriction practice is clearly established by Examiner Note Number 3 under Form Paragraph 8.15, which is found in MPEP 806.05(c). Specifically, Examiner Note Number 3 states "In bracket 4, suggest utility other than used in the combination." (Emphasis added) Unquestionably, the burden on the Examiner is to establish that the subcombination will have one or utilities that are different from the utility of the combination. Therefore, because the restriction requirement provides no such evidence of different utilities, the restriction requirement is improper for this reason as well.

As an illustrative example, utility is a fundamental requirement of US Patent Law

under 35 U.S.C. §101. Furthermore, all pending claims of the present application have utility under §101 for illuminating and cutting workpieces. Thus, it goes without saying, e.g., that claim 1 has utility and, e.g., dependent claims 2-7, 8-9, 10-15, 16-17 and 26 also have utility. However, the limitations of dependent claims 2-17 and 26 are not recited in claim 1 for the purpose of determining the broadest claims that are available to the Applicant. In spite of this fact, claim 1 naturally still has utility by itself. Thus, if the Examiner wishes to contend that a combination claim has a different utility from a subcombination claim, the Examiner must expressly identify a utility for the subcombination that is different from illuminating and cutting workpieces. Because the Examiner has completely failed to identify at least two different utilities for any of the restricted sets of claims, this restriction requirement can not stand under MPEP 806.05(c).

In fact, the Examiner has failed to particularly identify any specific utilities of the combinations and subcombinations. Therefore, Applicant has no basis for understanding what in fact are the allegedly different utilities of the combinations and subcombinations. Until the Examiner actually and specifically identifies at two allegedly different utilities, no prima facie case has been made pursuant to MPEP 806.05(c).

In summary, in order to properly establish a restriction requirement between a combination and a subcombination under MPEP 806.05(c), the Examiner has the burden of proving (i.e., providing material evidence that supports at least a prima facie case) by two-way distinctiveness that:

- (i) the subcombination is patentably distinct from the combination,
- (ii) the combination is also patentably distinct from the subcombination and
- (iii) the subcombination has a different utility from the combinations.

Because the Examiner has failed to provide sufficient material evidence concerning these three requirements, a prima facie case of patentably distinct inventions has not been made and the restriction requirement must be withdrawn. MPEP 803 and 808.

As a further independent basis for traversing this restriction requirement, Applicant questions the various classifications assigned by the Examiner to the various Groups of claims. For example, the Examiner classified the claims of Group I into class 83, subclass 520 and the claims of Group II into class 30, subclass 376. For convenience, the definitions of each of these classes are provided:

Class Definition of 83/520 - Device including means to illuminate or to cast a shadow on a part (or all) of the device or of the work; or means to form a light image of a part (or all) of the device or of the work, whether by reflection or refraction.

Class Definition of 30/376 - Device in which the means for changing the relationship between the blade and the work engaging surface permits the plane of cut to be changed relative to the plane of the work engaging surface.

Because claim 1 was essentially a generic claim to claim 18 before this Amendment (and after this Amendment is clearly generic), Applicant believes that both claims 1 and 18 should be classified together, or at least both claims 1 and 18 share a common classification, even though claim 18 may achieve an additional classification due to the additional limitations recited in claim 18. Further, Applicant can not discern which elements of claim 18 that are not recited in claim 1 require classification of claim 18 as a "device in which the means for changing the relationship between the blade and the work engaging surface permits the plane of cut to be changed relative to the plane of the work engaging surface." A clarification of the Examiner's basis for separately classifying claims 1 and 18 is hereby requested, as the classification does not appear to be consistent with the elements actually recited in claims 1 and 18.

Similarly, Applicant can not identify any particular elements of claims 2-7 that would cause claims 2-7 to be classified in class 30, subclass 388 instead of class 83, subclass 520. (Class Definition of 30/388 - Implement in which the saw element is rotated during the cutting operation.) That is, claim 83, subclass 520 appears to cover claims 2-7, as well. Thus,

Applicant contends that the Examiner's basis for classifying claim 1 in class 83, subclass 520, and claims 2-7 is in class 30, subclass 388 is not well-founded. Because the restriction requirement can not be based upon this alleged separate classification, examination of claims 2-7 is respectfully requested.

Furthermore, claims 8-9 also have been classified in class 83, subclass 520, which is the same classification as claim 1. Therefore, because claims 1 and 8-9 do not have a separate classification in the art, the Examiner has failed to demonstrate a substantial burden to examine claims 8-9 with the elected Group I(D), because both class 83, subclass 520 and class 30, subclass 517 must be considered during the examination of this application. Thus, because class 83, subclass 520 must be searched in order to examine claim 1, examination of claims 8 and 9 is also respectfully requested.

With respect to claims 10-15, Applicant notes that the elements recited in claims 10-15 substantially overlap with claim 16 and claims of Group I(D) (i.e., claims 16, 17 and 26) have been elected for prosecution. Because many of the limitations of claims 10-15 are recited in claim 16 and claim 16 must be examined at this time, Applicant contends that separate classifications of claims 10-15 and 16 are not warranted and further, there is no substantial burden to examine claims 10-15 with claims 16, 17 and 26. Therefore, examination of claim 10-15 is also hereby requested.

As noted above, separate classifications for claims 1 and 18 do not appear to be warranted in view of the fact that claim 1 is generic to claim 18. Furthermore, Applicant contends that examination of claims 1, 16, 17 and 26 will extend to the combination recited in claim 18. Therefore, examination of claim 18 is hereby requested. Similarly, in view of the overlap in searching fields for claims 19-22 and claims 1, 16, 17 and 26, Applicant contends that no substantial burden exists for refusing to examine these claims. Consequently, all pending claims (1-22 and 26) should be examined together.

Finally, according to Applicant's understanding of the Examiner's position, the Examiner contends that art relevant to claim 1 can be found in the classes defined by the dependent claims. That is, art relevant to claim 1 can be found in class 30, subclass 388 (claims 2-7), class 83, subclass 520 (claims 1 and 8-9), class 30, subclass 376 (claims 10-15) and class 30, subclass 517 (claims 16-17). Thus, a proper search for all prior art relevant to claim 1 requires searches in each of these separate classes. Because such searches in the separate classes are required to locate relevant art, as admitted by the Examiner, no additional search will be required to search claims 1-17 and 26, as well as claims 18 and 19, together in the same application. Therefore, Applicant requests reconsideration of the Examiner's classification and reconsideration of the Examiner's restriction requirement based upon the foregoing discussion.

For all the foregoing reasons, examination of claims 1-22 and 26 is hereby respectfully requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Paragraph [0005] has been amended as follows:

SUMMARY OF THE INVENTION

It is, accordingly, one object of the present [invention to teach] teachings to provide improved cutting tools that can effectively illuminate a portion of a workpiece that is being cut during a cutting operation.

According one aspect of the present teachings, cutting tools having improved illumination characteristics are taught that can also prevent or substantially reduce the amount of cutting chips that may scatter and adhere to a light during a cutting operation. For example, cutting tools are taught that have a light mounted within the blade case in a position that is laterally displaced [laterally] from a saw blade. Preferably, the light is directed along a line that is substantially parallel to the saw blade and the cutting line of the workpiece. The light may be optionally mounted on the blade case by means of a mounting device that is disposed within the blade case, so that the light can be disposed within the blade case.

Paragraph [0009] has been amended as follows:

In another aspect of the present teachings, a power supply circuit is provided to supply power to the light. In one embodiment of the present teachings, the power supply circuit may include a first coupling that may be disposed on [a] the side of the cutting tool that includes the motor. A second coupling may be disposed on the side of the cutting tool that includes the saw blade and light. Preferably, the motor side part and the light side part can be easily connected. For example, the coupling may be adapted to connect the motor side part and the light side part after the blade case has been joined to a motor housing that accommodates the motor. In addition or in the alternative, the coupling may be adapted to connect the motor side part and the light side part at the same time that the blade case is joined to the motor housing. Preferably, the motor is an electric motor and the power supply circuit also supplies power to the electric motor.

IN THE CLAIMS:

Claim 18 has been amended as follows:

18. (Amended) A cutting tool comprising:

a saw blade,

a blade case adapted to cover the saw blade,

a motor housing adapted to accommodate a motor for driving the saw blade,

wherein the blade case and the motor housing are formed separately from each other and are adapted to be joined to each other along a joining line,

a light adapted to illuminate a portion of a workpiece that will be cut by the saw blade during a cutting operation, wherein the light is laterally displaced from the saw blade and the light is substantially aligned with a cutting line of a workpiece that will be cut by the saw blade during a cutting operation,

a power supply circuit adapted to supply power to the light, wherein the power supply circuit comprises a first circuit portion disposed within the motor housing and a second circuit portion disposed within the blade case and

a coupling connecting the first circuit portion and the second circuit portion.